

REMARKS

In the Final Office Action¹ the Examiner rejected claims 31-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,963,925 to Kolling ("*Kolling*") in view of U.S. Patent No. 6,094,505 to *Lech* ("*Lech*").

By this amendment, Applicant amends claims 31, 39, 43 and 46. Support for the amendments can be found at least in the claims as originally filed and in the specification at, for example, page 18, line 20 - page 19, line 23. Claims 31-53 are pending.

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 31, insofar as it applies to the claim as amended, under 35 U.S.C. §103 as being obvious from *Kolling* in view of *Lech*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)*(*internal citation and inner quotation omitted*). "[T]he framework for the objective analysis for determining obviousness

¹ The Final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Independent claim 31 calls for a combination including, for example:

searching the first OCR data [extracted from the electronic image information by treating the electronic image information as a single zone] for at least one numeric identifier of a type of the scanned paper bill;
identifying the type of the scanned paper bill by comparing the at least one numeric identifier to a list of types stored in a memory; [and]
extracting second OCR data from the electronic image information using a template corresponding to the identified bill type, wherein the template includes zone information for locating portions of the billing information.
(Emphasis added).

The cited art, alone or in combination, fails to disclose or suggest at least these elements of claim 31.

On page 3 of the Final Office Action, the Final Office Action correctly concedes that “Kolling et al[.] does not explicitly recite the manner in which the paper bills were transformed or scanned into electronic bills or documents.” As discussed in the response filed on April 21, 2011, in *Lech* the user “use[s] the template to identify selected portions of information for extraction off of an image copy of the document”

(*Lech*, column 10, lines 35-40) There is no disclosure in *Lech* that the user “identif[ies] a type of the scanned paper bill,” much less that the user using any aspect of or quantity derived from “electronic image information,” as claimed.

However, the Final Office Action proposes modifying *Lech* to account for these claimed features. More particularly, the Final Office Action alleges on page 6 that *Lech* discloses:

obtaining a digital image of a canned [sic] bill of a given type of bills. Thus, there includes more than one specific bill in the system and method of *Lech*. See column 5, lines 52-57. [...] Thus, since all the digital documents are stored in memory and they are not the same because there includes a plurality of types of bills and invoices, it would have been obvious to one of ordinary skill in the art to note that if a desired document type is desired, then comparing the generated scanned image with a stored document would have been desired to do [sic] in order to assure that the type of desired document is accurately retrieved.

Even if the Examiner’s assertions were true, which Applicant does not concede, the Examiner’s proposed modification of *Lech* would still not account for all the features of claim 31, as amended.

First of all, there is no disclosure in *Lech* of “first OCR data” and “second OCR data,” as claimed. In fact, *Lech* discloses only a single data extraction step (see, e.g., *Lech* column 6, line 66 - column 7, line 19 and column 10, lines 30-65). Moreover, *Lech* also fails to disclose “first OCR data” extracted “from the electronic image information by treating the electronic image information as a single zone,” and that the “second OCR data” is extracted “using a template corresponding to the identified bill type,” as claimed. Neither *Lech* nor the Examiner’s proposed combination of *Kolling* with a modified *Lech* discloses or suggests at least “numeric identifier of a type of the scanned paper bill,” much less “searching the first OCR data” for the numeric identifier

and "identifying the type of the scanned paper bill by comparing the at least one numeric identifier to a list of types stored in a memory," as claimed.

In view of the deficiencies of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of independent claim 31 under 35 U.S.C. §103 as being obvious from *Kolling* in view of *Lech*, insofar as it applies to the claim as amended, is thus improper and should be withdrawn. The rejections under 35 U.S.C. §103 of independent claims 39, 43, and 46 should be withdrawn for at least the reasons given above with respect to claim 31 since claims 39, 43 and 46 recite similar elements as above.

Moreover, rejections under 35 U.S.C. §103 of claims depending from independent claims 31, 39, 43, and 46 are improper and should be withdrawn for at least reasons given above with respect to the independent claims.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the pending claims in condition for allowance. Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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